

## **II. RESPONSE TO OFFICE ACTION**

### **A. State of the Claims**

Contrary to the statements of the Action, claims 1-35, 37-39, 41-43, 45, and 47 were pending at the time of the Action. Claims 36, 40, 44, and 46 were canceled without prejudice or disclaimer in the Preliminary Amendment filed concurrently with the application.

In the Action, the Examiner entered a restriction requirement between the Group I invention (claims 34, 35, 37-39, 41-43, 45, and 47) and the Group II invention (claims 1-33). Applicants' oral election of the Group II invention for prosecution in the present case is confirmed below, and the claims of the Group I invention have been canceled without prejudice or disclaimer from the present application.

In the Preliminary Amendment submitted simultaneously with the application, Applicants elected the species "methods for stripping nucleic acid using enzymes." Therefore, the Examiner has withdrawn claims 9, 10, 16, and 17 from further consideration as being drawn to a non-elected species in the Action. In view of Applicants' belief that the present claims, which include claims generic to all specific species, are allowable, the subject matter of claims 9, 10, 16, and 17 should be reintroduced into the present case and those claims should be allowed.

Applicants have amended claims 1, 20, 31, and 33, without prejudice or disclaimer. Support for these amendments is found in the specification and claims as originally filed. No new matter is added by these amendments.

Therefore, claims 1-33 are pending in this application after entry of the Amendment submitted herewith.

**B. Confirmation of Restriction Requirement**

Applicants affirm the election of the Group II invention (claims 1-33) made during a telephone conversation between Applicants' representative, Mark B. Wilson, and the Examiner on November 4, 2003.

Applicants further affirm the election of the species "methods for stripping nucleic acids using enzymes" as set forth in the Preliminary Amendment. Applicants understand that claims 9, 10, 16, and 17, which were drawn specifically to other species, were not considered in the Action. However, in view of the allowability of claims generic to claims 9, 10, 16, and 17, the subject matter of these claims should be reintroduced into the case and allowed at this point in time.

**C. References Cited by Applicants in Form PTO-1449 Not Considered**

Applicants note that in conjunction with the Action, the Form PTO-1449 submitted upon filing of the application was returned. Unfortunately, Refs. C6 through C11 were stricken through on the Form 1449 by the Examiner, apparently because the Examiner was unable to obtain the parent file containing those references.

Applicants properly submitted an IDS and Form 1449 in this application in accordance with PTO rules and regulations. Applicants were not given an opportunity to submit copies of the references included on the Form 1449 once the Examiner was unable to locate them in the parent file. Further, Applicants had no notice that the Examiner was unable to obtain the copies of the references already made of record with the PTO prior to receipt of the Action. Therefore, it would be improper to issue as a next Office Action in this case a Final Office Action including any prior art rejections based on the cited references.

**D. The Rejections under 35 U.S.C. § 112, Second Paragraph, are Overcome**

The Action raises several rejections to the claims under 35 U.S.C. § 112, second paragraph. These are overcome as discussed below.

The Action suggests that the term “nucleic acid probe” in claim 1 is relative and renders the claim indefinite as it is not defined by the claim. Applicants, as an initial point, point out that those of skill in the art of molecular biology certainly understand what a “nucleic acid probe” is. However, in order to progress this case toward allowance, Applicants have amended claim 1 to recite that the nucleic acid probe is “hybridized to” the sample nucleic acid. Therefore, it is abundantly clear that the nucleic acid probe is a nucleic acid which hybridizes to the sample nucleic acid, as those terms are understood in molecular biology.

The Action rejects claims 1 and 31 as omitting essential steps, the essential step being the breaking of at least a first bond of the nucleic acid probe. As an initial point, Applicants do not understand how this particular rejection is germane to claim 31, which deals with the obtaining of a sample nucleic acid hybridized to a nucleic acid probe and is dependent upon claim 1. However, Applicants would submit that current claim 1 contains language clearly setting forth this step and that this rejection is overcome.

Regarding the Action’s rejection that claim 20 was vague and indefinite because it was unclear where the term “attaching” was intended to be included in the steps of the method, Applicants submit that current claim 20 is clear as drafted.

**E. The Obviousness-Type Double Patenting Rejection is Overcome**

The Action raises an obviousness-type double patenting rejection over issued U.S. Patent No. 6,365,731. Applicants have submitted herewith an appropriate Terminal Disclaimer over the ‘731 patent. Therefore, the obviousness-type double patenting rejection is overcome.